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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/995,009	11/26/2001	David B. Miller	127P67USC1	1384

23322 7590 04/16/2007
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MINNEAPOLIS, MN 55418

EXAMINER

OMGBA, ESSAMA

ART UNIT	PAPER NUMBER
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3726

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
2 MONTHS	04/16/2007	PAPER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/995,009
Filing Date: November 26, 2001
Appellant(s): MILLER, DAVID B.

MAILED

APR 16 2007

Group 3700

Michael L. Mau
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed September 2, 2005 appealing from the Office action mailed May 17, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,321,879	OETIKER	6-1994
4,425,781	OETIKER	1-1984

Applicant's Admitted Prior Art (AAPA), page 1 of the specification filed November 26, 2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7 and 8 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Appellant's Admitted Prior Art (AAPA) in view of Oetiker'879 (US Patent 5,321,879) or Oetiker'781 (US Patent 4,425,781).

Appellant, at page 1 of the specification to be known as AAPA, discloses a method of making a clip and irrigation hose assembly wherein a wound hose is delivered to a site where it is unwound and clips are manually attached to the hose typically by a snap fit. AAPA does not disclose the clip being pre-assembled to the hose before being shipped to a site as a clip and hose assembly for subsequent installation of the hose with the clips already assembled to the hose. However it is known to preinstall clips on objects to be fastened as attested by Oetiker'879, see column 1, lines 22-34, column 2, lines 19-38 and the abstract, or Oetiker'781, column 2, lines 25-30 and column 4, lines 38-47 . Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made, to have pre-assembled the clips of AAPA on

the hose before shipping the hose to a different site, in light of the teachings of Oetiker'879 or Oetiker'879, in order to save time on assembly. Appellant should note that clips with inner diameters sized and configured to be secured around the hose and to also be moveable on the hose are old and well known in the art. Regarding the limitation of claim 8, Appellant should also note that Oetiker teaches an automatic process to secure the clips. Furthermore it has been held that broadly providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routine skill in the art. *In re Venner*, 120 USPQ 192.

(10) Response to Argument

Appellant's arguments filed September 2, 2005 have been fully considered but they are not persuasive.

In response to Appellant's argument that there is no suggestion to combine the references and that there is no off-site use suggested by the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both Oetiker'781 and Oetiker'879 teach preassembling clamps to a hose or axle boots and shipping the preassembly to an end user as opposed to shipping the clamps and hose or axle boots separately to the end user and having the end user assemble the clamps to the hose or axle boots, see

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column 1, lines 22-33 of Oetiker-879 which reads as follows ***“open clamps which are already preformed into substantially circular configuration are placed about the axle boots, are manually closed by engagement of the hooks provided on the inner band portion in apertures in the outer band portion and are thereafter fastened by contraction of the so-called “Oetiker” ear. It is also known to ship open clamp structures to the user as flat blanks for space- and cost-saving reasons and to deform the flat blanks into a predetermined shape at the user”***.

See also column 2, lines 25-30 and column 4, lines 38-47 of Oetiker which read as follows respectively: ***“To fully appreciate the importance of the present invention, it is also necessary to consider those cost factors that accrue as a result of shipping and handling of the clamps structures between the place of manufacture and the place of actual use of the clamps when installed, for example, at the assembly line”***, and ***“Of course it is also possible for the operator not only to preassemble the preformed open clamp structure over the object to be to be fastened, but also to complete the assembly... It is thus clear that the final tightening of the clamp structure by contracting the ear can take place at any suitable location along the assembly line, for instance, at a place remote from the location of preassembly”***. The examiner submits that the preceding clearly teach “off-site use” contrarily to Appellant’s argument.

In response to Appellant's argument that the Oetiker references are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem

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with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Oetiker is teaching pre-assembly of clamps and hose to form an assembly and shipping the assembly to an end user thus eliminating the assembly of the clamps on the hose by the end user prior to installing the hose, saving time and labor to the end user and ensuring that the clamps are situated at the correct location on the hose, that is substantially the same problem that Applicant was concerned with. The concept of shipping as a pre-assembled unit two elements that were previously shipped separately is what is taught by the Oetiker references and therefore is relevant to what Appellant was concerned with. Whether the hose is an irrigation hose or not lends is inconsequential.

In response to Appellant's argument that the proposed combination, even if made, would not work, and that if the clamps of the Oetiker patent were used, they would not be adjustable and the drips of water could not be precisely located as is required in the irrigation art, the examiner submits that in as much as the problem with which Appellant was concerned is shipping as a pre-assembled unit two elements that were previously shipped separately and assembled by the end user, then the proposed combination would work. One of ordinary skill in the art would know to use appropriate sized clamps depending on the particular application. Furthermore it is noted that the features upon which Appellant relies (i.e., the drips of water could not be precisely located as is required in the irrigation art) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the

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specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

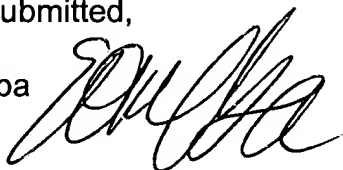
(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Essama Omgba



Conferees:

David Bryant, SPE 3726



Marc Jimenez, TQAS 3700

